

## REMARKS/ARGUMENTS

### *Amendments in General / Claim Rejections - 35 U.S.C. § 112*

1. Claims 1-10 were rejected under § 112 first paragraph due to the phrase "supple." Applicant has amended claims 1 and 5 to remove the "supple" and "decorative" terminology added in the previous Response. Such change adds no new matter.

### *Claim Rejections - 35 USC § 102*

2. The Examiner rejected claims 1 and 5-7 under §102(b) as being anticipated by Ratzlaff.
3. The Examiner rejected claims 5-6 and 8 under §102(b) as being anticipated by Weightman.
4. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.
5. Although Applicant disagrees with the rejection, in the interests of obtaining a speedy allowance, claims 1 and 5 have been amended to include the limitations of claim 4 and 10 (respectively), namely that elastic strips are used to provide the cover with a gathered configuration. Claims 4 and 10 were subsequently cancelled. Such changes add no new matter.
6. Ratzlaff does not disclose such an element. Weightman does not disclose such an element. As such, Ratzlaff and Weightman are not §102(b) art.

***Claim Rejections - 35 USC § 103***

7. The Examiner rejected claims 1 and 5-7 under §103(a) as being obvious by Padilla in view of Petock.

8. The Examiner rejected claims 1-3 and 5-9 under §103(a) as being obvious by Ratzlaff in view of Simmons.

9. The Examiner rejected claims 4 and 10 under §103(a) as being obvious by Ratzlaf in view of Tomberlin.

10. The Examiner rejected claims 1-3, 7 and 9 under §103(a) as being obvious by Weightman.

11. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 706.02(j).

12. The independent claims, as amended, now contain a limitation regarding elastic strips. None of Padilla, Petock, Ratzlaff, nor Weightman include such an element. As such, the rejections of: (a) claims 1 and 5-7 under §103(a) as being obvious by Padilla in view of Petock; (b) claims 1-3 and 5-9 under §103(a) as being obvious by Ratzlaff in view of Simmons and (c) claims 1-3, 7 and 9 under §103(a) as being obvious by Weightman are all moot.

13. The only rejection to be addressed is: claims 4 and 10 under §103(a) as being obvious by Ratzlaf in view of Tomberlin.

14. In making the original rejection, the Examiner noted (page 4 of the first Office

Action) that “Tomberlin disclose [sic] a cord covering (10) provided with hemmed edges containing elastic strings (40)...[i]t would have been obvious to...provide Ratzlaff with hemmed edges with elastic string...”

15. However, Tomberlin does not disclose elastic strings. The word elastic or its equivalent does not occur in the application. Tomberlin merely discloses strings 34 and 36 having free ends 38 and 40 (col. 3, ll. 24-28). Such strings are not implicitly or explicitly elastic. They are merely strings.

16. Because neither Tomberlin nor Ratzlaff supply the missing element, the §103(a) rejection is improper and should be withdrawn.

#### *Non-Analogous Prior Art*

17. Only references from arts analogous to that of the claimed invention may comprise prior art to the invention. A reference will only be analogous art if: 1) it is from the same field of endeavor as the claimed invention; or 2) it is from a different field of endeavor, but the reference is reasonably pertinent to the particular problem solved by the inventor. *In re Oetiker*, 977 F.2d 1443, 1446-47 (Fed. Cir. 1992); *In re Clay*, 966 F.2d 656, 658-89 (Fed. Cir. 1992). In the *In re Clay* case, the subject claims were directed to a process which improved removal of oil products from storage tanks. The Examiner in that case cited a patent directed to improving production of oil from underground formations. The Federal Circuit held that the cited patent was not analogous art even though the cited patent and subject application both related to the oil industry.

18. It is applicant's position that the Ratzlaff reference is not within the field of Applicant's endeavor and not reasonably pertinent to the particular problem with which the inventor was concerned because a person of ordinary skill, seeking to solve a problem regarding the design decorative electrical cord covers would not reasonably be expected or motivated to look to art including external pipe protectors for protecting steel or plastic pipe against damage.

*Conclusion*

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below. Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 3<sup>rd</sup> day of April 2006.

Very respectfully,



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